

REMARKS

Applicant's attorney wishes to thank Examiner Bochna for the courtesies of the telephone interviews of Thursday, September 4, 2003. The amendments as contained in independent Claim 18 were discussed with the Examiner. At the end of the conversations, Applicant's attorney indicated that he would (a) make the changes in independent Claim 18 as indicated herein above; (b) submit an affidavit of secondary considerations under *Graham v. John Deere*, 383 U.S. 1 (1966); and (c) respond to the Examiner's rejection as contained in his Office Action of August 28, 2003. Examiner Bochna indicated that after a further review, if nothing else was found, he would consider these changes for allowance of the application.

A. Summary of Office Action

Claims 18 through 23 were presented for examination.

Claims 18 through 21 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Blount, et al in view of the Mid-Continent Water Well Casing and Screens Catalogue. Blount was the primary reference used.

Claim 22 was rejected under Blount in view of Singleton under 35 U.S.C. §103(a).

Additionally, Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Blount alone.

B. Blount Reference

As was pointed out to the Examiner, Claim 18 as amended claims a "single piece polyvinyl chloride (PVC) pipe . . . of a substantially uniform circumference at the male end".

If the Examiner will look at Fig. 1 of Blount, a single piece of metal pipe is shown, but it does not have the "first enlarged interior diameter" and the "second enlarged interior

diameter". To get the first and second enlarged interior diameter, the Examiner has to refer to Figs. 2 and 3 in the Blount reference.

Referring to Figs. 2 or 3 of the Blount reference, while the "first enlarged interior diameter" and "second enlarged interior diameter" are shown, it was only by adding extra pieces, such as tool joints 68 or 72, that the "first enlarged interior diameter" and "second enlarged interior diameter" were added. In other words, it is no longer a single piece pipe when the first and second enlarged interior diameter are added.

Also as was pointed out to the Examiner, Blount has an enlarged male end as is shown in box member 63 of Fig. 3 or in box member 33 of Fig. 2. The enlarged box member 63 or 33 on the male end of the pipe is contrary to the limitation of a "substantially uniform circumference at the male end". Clearly the Blount reference does not meet this limitation.

As was previously pointed out to the Examiner, the Blount reference is a metal pipe which is more expensive, heavier, and will have a tendency to corrode. Blount even talks about use of a "corrosive resistant metal" (see column 1, lines 32 and 33). Also Blount make is very clear that the pipe is made of "conventional ferrous metals" (see column 3, line 70), but inserts the liner 12 to help stop corrosion. By making the present invention out of a PVC material, corrosion is no longer a problem.

However, PVC pipes do not have the strength of metal pipes and may have a tendency to break or crack at the joints. The present invention solves the problem of the PVC pipe breaking or cracking at the joint (See affidavit of Morris G. Haney).

The present claimed invention is much easier and more economical to make than the Blount invention. The Blount invention is made out of a ferrous metal with a liner and,



hence, is going to be much more expensive than the present single extruded PVC pipe. The adding of additional elements, such as tool joints 68 and 72 shown in Blount, also add to the expense.

C. Mid-Continent Water Well Casings and Screens Catalogue

The Mid-Continent Catalogue was cited as providing a pipe made out of the same material as Applicant's claimed invention and then combined with the Blount reference for a §103 rejection. As was previously pointed out to the Examiner, the large casing shown in the Mid-Continent Catalogue has a solvent weld and is therefore not "reusable" as is specifically claimed in the present invention. Further, the Mid-Continent Catalogue does not provide a clearly defined "first enlarged interior diameter" and "second enlarged interior diameter", but instead has generally sloping surfaces and tapered threads.

Lastly, the portion of the pipe extending beyond the threads on the female end is very short. This very short extension beyond the threads on the female end would not be long enough to provide "lateral strength" as is specifically claimed in the present invention. The casing shown in the Mid-Continent Catalogue has very little lateral support. The claim limitations specifically claims "said second enlarged interior diameter being at least long enough to receive most of said external threads from said similar adjacent PVC pipe therein before threading". This is not present in the Mid-Continent Catalogue disclosure for the large casing connection.

D. Singleton Reference

Applicant does not dispute that Singleton shows triangular threads as indicated by the Examiner. The only part Applicant disputes is whether or not it would have been obvious to further modify Blount to provide the triangular threads as taught by Singleton.



The arguments as made herein above would apply with the further combination of the Singleton reference making the claimed invention even less obvious.

RULE 132 AFFIDAVIT

Attached hereto is the "Affidavit of Morris G. Haney under 37 C.F.R. 1.132" giving secondary considerations in determining patentability. Mr. Haney has over 40 years experience in the water well business. Mr. Haney in his Affidavit points out the problems that have existed for years, which problems constitute a long felt need in the industry. Problems have continually existed concerning the pipes corroding, leaking, cracking, and/or breaking. Others have failed over the years to rectify those problems.

On the other hand, immediately upon the present invention being sold and offered for sale by modest sized company (Modern Products Industries, Inc.), it met with tremendous commercial success. Even a worldwide company began copying the product as covered by the present application.

The secondary considerations of patentability should be considered by the Examiner as is required under *Graham v. John Deere*, 383 U.S. 1 (1966). While Applicant believes the secondary considerations are not necessary for patentability of the present invention, certainly when the secondary considerations are added, it clearly tips the scale in favor of patentability.

CONCLUSION

For the reasons given herein above, Applicant respectfully requests that the Examiner promptly issue a Notice of Allowance of the above-identified application. Applicant's attorney would appreciate receiving a Faxed copy at his FAX number of (210) 886-9883. If a telephone interview would further help place the application in condition

for allowance, it is respectfully requested. On the other hand, If the Examiner does not believe the application should be allowed, entry of the Amendment After Final is respectfully requested for purposes of appeal.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred therein) is being sent by facsimile to (703) 746-3578 on September 5, 2003.

Kerrye Stevens

Printed Name of Person Faxing Paper or Fee

Kerrye Stevens

Signature of Person Faxing Paper or Fee

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Morris G. Haney and Roy L. Thein	ATTY DKT NO.: P-7627
SERIAL NO.: 09/989,512	GROUP ART UNIT: 3679
FILED: November 20, 2001	EXAMINER: David Bochna
TITLE: Submersible Pump Drop Pipe and Casing Assembly Connection and Method of Manufacture	
TO: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	

AFFIDAVIT OF MORRIS G. HANEY
UNDER 37 C.F.R. 41.132

I, Morris G. Haney, being duly sworn, depose and state the following:

1. I am over 21 years of age and am competent to make this affidavit.
2. I am one of the co-inventors in the above-identified application.
3. My father before me was in the water well business, and I followed in his footsteps. I have been in the water well business for approximately 40 years.
4. For approximately 31 years I have worked for Modern Products Industries, Inc. or its predecessor companies. Modern Products Industries, Inc. is the assignee of the above-identified application.
5. Modern Products Industries, Inc. makes plastic pipe that is commonly used in the water well industry. I have personally been in charge of making plastic pipe for use in the water well industry for many years.

[Handwritten signature]

6. Prior to our present invention, there has been a long felt need in the industry to develop a simple and inexpensive method of joining water well pipes. If a metal pipe, such as galvanized pipe is used, it would have a tendency to corrode plus, being very heavy and difficult to use. After a period of corrosion, the pipe joint would start to leak.

7. If a plastic pipe was used, it required additional fittings. The additional fittings would have a tendency to break, again causing leakage. Stainless steel pipe was too expensive to use. All of the different types of methods that had been used in the past provide a good, reliable joint between different sections of pipe required multiple parts and would have a tendency to crack and leak.

8. Others in the past have attempted to solve the problem but have been unsuccessful in doing so. In the past, the attempts to solve the problem included adding additional joints or fittings to solve the problem of cracking or leaking in water well pipes. None of these methods were satisfactory and were more expensive and cumbersome to use than the present invention.

9. After my co-inventor and I came up with our invention, it was met with tremendous commercial success in the market place.

10. Modern Products Industries, Inc. is a modest size company with sales last year being slightly in excess of \$11 million dollars. Since late 2001, when our invention was introduced in the market place, sales of our invention are now almost one-fourth of the sales of Modern Products Industries, Inc. Despite the modest size of Modern Products Industries, Inc., and since the time of introduction of our invention, the sales of our invention are as follows:

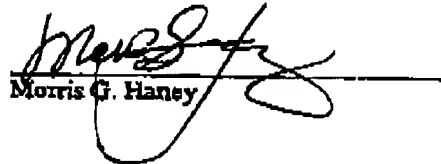
YEAR	SALES
2001	\$169,988
2002	\$1,838,338
2003 thru July 31, 2003	\$1,598,722

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11. After our product was introduced in the market place and was finding tremendous acceptance by the well drilling industry, Certainteed Corporation, one of the largest competitors in our industry and a worldwide company, started copying our invention. Not only did we have tremendous success in the market place with our invention, but also the competitor, Certainteed Corporation, copied our invention.

12. Based upon my 40 years experience in the water well business, it is clear that (a) there was a tremendous need in the industry for a water well pipe such as is described in our parent application; (b) there was a failure of others to solve the problem our invention solves; and (c) our invention immediately upon introduction into the market place met with tremendous commercial success.

Further, Affiant sayeth not.


Morris G. Haney

STATE OF TEXAS

COUNTY OF BEXAR

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BEFORE ME, the undersigned authority, on this day personally appeared MORRIS G. HANBY, known to me to be the person of that name, who signed the foregoing instrument, and acknowledged the same to be his free act and deed.

GIVEN under my hand and seal of office this 4th day of September, 2003.


Notary Public

SHIRLEY MCINTYRE
Printed Name of Notary

Commission Expires 4/26/05

Notary Public, State of Texas, Commission Expires 4/26/05



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